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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,526	07/11/2003	Frits Jacobus Fallaux	2578-3833. 9US	5055
24247	7590	04/06/2005		
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110				
EXAMINER				
NGUYEN, DAVE TRONG				
ART UNIT		PAPER NUMBER		
1632				

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/618,526

Applicant(s)

FALLAUX ET AL.

Examiner

Dave T. Nguyen

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-7, 9-12, 14-16 and 18-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9-12, 14-16, 18-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Claims 1, 3-7, 9-12, 14-16, 18-28 have been amended; and claims 2, 8, 13, and 17 have been canceled by the amendment filed February 24, 2005.

The terminal disclaimer with respect to Pat No. 5,994,128 has been entered.

The signed Declaration regarding the compliance of the deposit rules with respect to the PER.C6 cell line has been entered.

The examiner acknowledges the personal interview with applicants on Feb. 8, 2005, and the discussion regarding the interview is correct.

As the result of the claimed amendment, all rejections under 35 USC 112, first paragraph are withdrawn by the examiner.

The prior art rejections are also withdrawn by the examiner because of the prior art of record, e.g., Imler, Wilson, Graham, do not teach an isolated adenovirus packaging cell, wherein its genome comprises a first nucleic acid sequence encoding E1A and E1B gene products; but lacks a nucleic acid sequence encoding adenovirus pIX.

Claims 1, 3-7, 9-12, 14-16, 18-28, to which the remaining grounds of rejection remain applicable are pending.

### **Double Patenting Rejection**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-7, 9-12, 14-16, 18-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over any of claims 1-14 of US Pat No. 6,033,908, claims 1-5 of US Pat No. 6,265,212, claims 1-14 of US Pat 6,306,652, or claims 1-12 of US Pat No. 6,692,966.

The claims are obvious variants because all set of claims encompass the make and use of:

A packaging cell for production of replication defective adenovirus vectors comprising a packaging construct comprising nucleotides 459-3510 of a human adenovirus 5 genome wherein said cell lacks an adenovirus gene coding for functionally active pIX gene products, and wherein said cell comprises nucleic acid sequences coding for functionally active E1A and E1B gene products under the control of a promoter.

Thus, the patent claims and the application claims are obvious variant of one another.

Claims 1, 3-7, 9-12, 14-16, 18-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over any of claims 26-34 of US Application 10/125,751, and claims 21, 9, and 10 of US Application No. 10/219,414.

The claims are obvious variants because all set of claims encompass the make and use of:

A packaging cell for production of replication defective adenovirus vectors comprising a packaging construct comprising nucleotides 459-3510 of a human adenovirus 5 genome, wherein said construct lacks an adenovirus gene coding for functionally active pIX gene products, and wherein said construct comprises nucleic acid sequences coding for functionally active E1A and E1B gene products under the control of a promoter.

Thus, the patent claims and the application claims are obvious variant of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Dave Nguyen* whose telephone number is **571-272-0731**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ram Shukla*, may be reached at **571-272-0735**.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Central Fax number, which is **571-273-8300**.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

**For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.**

Art Unit: 1632

Dave Nguyen  
Primary Examiner



**DAVE TRONG NGUYEN**  
**PRIMARY EXAMINER**